

**Remarks/Arguments**

Reconsideration of the above-identified application in view of the present amendment is respectfully requested. By the present amendment, claim 14 has been amended. New claims 43 and 44 have been added.

**Claim Rejections under 35 U.S.C. §102**

Claims 1-9, 12 and 14 were rejected under 35 U.S.C. §102 as being anticipated by Vetillard (WO 0206441) - see English language equivalent (US 20040132175) for a translation.

The Examiner asserts that Vetillard expressly meets all the limitations of the claim except for the recitations directed to transmitting hydrostatic pressure. The Examiner alleges, however, that reciting a loading module that transmits hydrostatic pressure constitutes a recitation of intended use and, thus, the prior art need only *be capable of* performing the intended use to anticipate the claimed subject matter (Office Action page 9). The Examiner further asserts that structural limitations must be added to further define claim 1, or it must be persuasively argued that Vetillard is incapable of practicing the claimed intended use (Office Action page 9).

Claim 1 is not anticipated by Vetillard because: (1) the recitation in claim 1 that a hydrostatic loading module transmits hydrostatic pressure through a membrane is a functional limitation and not a recitation of intended use; (2) Vetillard does not teach or suggest the subject matter recited in claim 1; and (3) structural similarities between Vetillard and illustrated embodiments of the present invention are irrelevant in assessing whether Vetillard anticipates claim 1.

1. **The recitation in claim 1 that a hydrostatic loading module transmits hydrostatic pressure through a membrane is a functional limitation and not a recitation of intended use**

The MPEP states that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure, *e.g.*, statements of intended use (MPEP §2111.04). In the present case, claim 1 positively recites a hydrostatic – not hydrodynamic – loading module. Moreover, claim 1 positively recites a hydrostatic loading module that not only is capable of transmitting hydrostatic pressure through a membrane, but a loading module *that actually transmits* hydrostatic pressure through the membrane. In other words, claim 1 does not make optional, but actually requires 1) a *hydrostatic* loading module that 2) *actually transmits* hydrostatic pressure through a membrane.

In fact, the recitation that the hydrostatic loading module transmits hydrostatic pressure is a functional recitation and not a statement of intended use. More specifically, claim 1 recites structure, *i.e.*, the hydrostatic loading module, which performs a specific function, *i.e.*, transmitting hydrostatic pressure through the membrane to the first liquid medium. Since the recitations in claim 1 are not optional but structural and functional these recitations are not directed to statements of intended use and, thus, they must be given patentable weight.

Courts have noted that there is nothing inherently wrong with defining some part of an invention in functional terms. In re Swinehart, 439 F.2d 210 (CCPA 1971). In particular, the Swinehart court noted that:

“Functional” terminology may render a claim quite broad.  
By its own literal terms a claim employing such language

covers any and all embodiments which perform the recited function. . . That is not to say, however, that every claim containing “functional” terminology is broad. Indeed, in many cases it will be obvious that only a very limited group of objects will fall within the intended category.

Id. at 213. Along those lines and according to the MPEP, a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP §2173.05(g) (emphasis added). The only instance in which functional language is not given patentable weight occurs when the functional limitations are found to be inherent in the prior art. In re Schreiber, 128 F.3d 1473 (Fed. Cir. 1997). This is not the case here.

In claim 1, one having ordinary skill would readily understand, in light of the specification, that which the Applicants are claiming by reciting that the hydrostatic loading module transmits hydrostatic pressure through the membrane to the first liquid medium (see Page 13, lines 25-28 and Page 16, line 14-27; Fig. 2). These recitations are clear and definite to one having ordinary skill and, thus, are not overly broad. These limitations define the interrelations and functions of the hydrostatic loading module, the membrane, and the first liquid medium, and the specification clearly defines which features perform these functions and how those functions are performed. Accordingly, all limitations, including the functional limitations of claim 1, must be given patentable weight.

**2. Vetillard does not teach or suggest the subject matter recited in claim 1**

Vetillard does not teach or suggest 1) a hydrostatic loading module or 2) a hydrostatic loading module that actually transmits hydrostatic pressure through a

membrane. The Examiner asserts that zones C1 and C3 in Vetillard constitute hydrostatic loading modules and that the “downward phase” and “ascending phase” are created by varying pressure within the hydrostatic loading modules (Office Action page 3). In Vetillard, however, these phases are always conducted under hydrodynamic conditions – not hydrostatic. In particular, Vetillard teaches that, during the downward phase, the pump P1 continually circulates nutritive media F1 from the vessel R1, through the zone C1, and back into the vessel (Figs. 2 and 6). In other words, the nutritive media F1 is not constrained or otherwise held static within the zone C1 at any time. Accordingly, the nutritive media F1 is constantly moving through the zone C1 and thereby applies hydrodynamic pressure  $p_1$  through the membrane M1 and into the zone C2. The pressure  $p_1$  forces waste products to drain from the zone C2, through the membrane M3, into the zone C3, and out of the system via a valve V3 (Fig. 2). This drainage is accomplished while the pump P3 is inactive, i.e., when no fluid is supplied to the zone C3 and, thus, no pressures of any kind are exerted from the zone C3 towards the membrane M3 during the descending phase. Therefore, the only forces present during the downward phase are hydrodynamic forces.

Likewise, during the ascending phase, the pump P3 circulates dynamic liquid media F3 from the tank R3, through the zone C3, and into the waste disposal tank (Fig. 6). In other words, the liquid media F3 is not constrained or otherwise held static within the zone C3 at any time. Accordingly, the liquid media F3 is constantly moving and applies hydrodynamic pressure  $p_3$  through the membrane M3 and into the zone C2, thereby causing nutrients in the media F3 to ascend through the

zone C2 and into the zone C1 to replenish the tank R1 of fresh nutrient media F1 (Fig. 3). This replenishing is accomplished while the pump P1 is inactive, i.e., when no fluid is supplied to the zone C1 and, thus, no pressures of any kind are exerted from the zone C1 towards the membrane M1. Therefore, the only forces present during the ascending phase are hydrodynamic forces.

Vetillard teaches that, this inversion of flow from the zone C2 back into the zone C1 makes it possible to create trans-membrane flows subjected to low hydrodynamic stresses compatible with the fragility of the cultivated cells. Thus, a system of “laminar” slow flows is obtained (Paragraph 144 – emphasis added). Based on the foregoing, it is clear that any pressure applied through the membranes M1 or M3 is due to hydrodynamic forces. In other words, neither zone C1 nor zone C3 taken alone or in combination with liquid media F1 and F3, respectively, constitute a hydrostatic loading module that transmits hydrostatic pressure through a membrane. Accordingly, Vetillard does not teach or suggest the subject matter recited in claim 1.

**3. Structural similarities between Vetillard and illustrated embodiments of the present invention are irrelevant in assessing whether Vetillard anticipates claim 1**

The Examiner asserts that since the physical structure of the claimed invention and that of Vetillard are identical, there is no reason to believe that the Vetillard system is incapable of being operated according to the hydrostatic pressure intended use recited in claim 1 (Office Action page 9). The Applicants disagree with this rationale.

It is well established that it is the function and purpose of claims, not the written description part of the specification itself, to delimit the right to exclude. Markman V. Westview Instruments, Inc., 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995) (in banc). If structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Crystal Semiconductor Corp. v. TriTech Microelectronics International, Inc., 246 F.3d 1336, 1345-46, 1347, 57 USPQ2d 1953 (Fed. Cir. 2001). Moreover, courts have noted that limitations appearing in the specification will not be read into the claims, and that interpreting what is *meant* by a word *in* a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper' Intervet America, Inc. v. Kee-Vet Laboratories, Inc., 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). Likewise, adding limitations to claims not required by the claim terms themselves, or unambiguously required by the specification . . . is impermissible. Gary v. Logitech, Inc., 254 F.3d 1334, 1342-43, 59 USPQ2d 1290 (Fed. Cir. 2001).

In other words, any structural similarities between a prior art reference and an embodiment of an application are inconsequential in determining whether the prior art reference teaches the positively recited subject matter in the application. In the present case, since claim 1 positively recites a 1) *hydrostatic* loading module 2) *that transmits* hydrostatic pressure any structural similarities between the cell culture chamber in Vetillard and a particular embodiment of the bioreactor system 10 illustrated in the drawings of the present invention are wholly irrelevant in assessing whether Vetillard teaches the subject matter positively recited in claim 1. Based on

the foregoing, it is respectfully submitted that Vetillard does not teach or suggest the subject matter recited in claim 1 and, thus, it is respectfully submitted that claim 1 is patentable over Vetillard and is therefore allowable.

Claim 2 recites that the hydrostatic loading module transmits the pressure by a static second liquid medium. As noted, Vetillard teaches a bioreactor in which both the fresh nutrient media F1 and the liquid media F3 are continually in motion while being perfused through the zones C1 and C3, respectively. Accordingly, Vetillard does not teach or suggest a hydrostatic loading module that transmits pressure by a static second liquid medium. For these reasons, it is respectfully submitted that claim 2 is patentable over Vetillard and is therefore allowable.

Claims 3-9, 12, and 14 depend from claim 1 and are allowable for at least the same reasons as claim 1 and for the specific limitations recited therein.

Claim Rejections under 35 U.S.C. §103

Claims 1-14 and 42 are rejected under 35 U.S.C. §103(a), as being unpatentable over Vetillard (WO 0206441) in view of Jensen (US20040077075). It is respectfully submitted that a *prima facie* case of obviousness has not been shown because one having ordinary skill would not modify Vetillard to include the teachings of Jensen.

Claim 1 recites a bioreactor that includes a housing defining a first chamber that contains a first liquid medium. At least one gas permeable membrane defines at least a portion of the housing. The membrane allows gas flow through the housing into the first chamber. A hydrostatic loading module transmits hydrostatic pressure through the membrane to the first liquid medium contained in the first chamber.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 35 U.S.C. §103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In making a determination of obviousness under 35 U.S.C.

§103(a):

...the scope and contents of the prior art are determined; the differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. Graham v. John Deere, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966).

In *KSR Int'l. Co. V. Teleflex, Inc.*, the U.S. Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. §103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the manner claimed.” 127 S. Ct. 1727, 1741; 2007 U.S. Lexis 4745; 167 L. Ed. 2d 705; 75 U.S.L.W. 4289 (2007).

In considering the question of *prima facie* obviousness, the Federal Circuit has consistently held that when a rejection under 35 U.S.C. §103 is based upon a modification of a reference that destroys the intent, purpose, or function of the



invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot be properly made. See, *In re Gordon*, 733 F.2d 900, 221 USPQ1125 (Fed. Cir. 1984). Also, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 791, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); See also, MPEP §2145 X.D.2. Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the present case, modifying the bioreactor of Vetillard to operate under hydrostatic pressure as taught in Jensen changes the principle of operation of the Vetillard bioreactor and, thus, such a modification is not obvious to one having ordinary skill. Vetillard teaches that dynamic fluid media F1 is selectively circulated through the zone C1 in order to supply growth hormones and large proteins to the culture chamber C2 while draining wastes from the culture chamber. Likewise, the dynamic fluid media F3 is selectively circulated through the zone C3 in order to replenish the fluid media F1 with fresh nutritive elements from the fluid media F3 (Paragraphs 138 and 141; Figs. 2-6).

The Examiner asserts that if Vetillard does not disclose transmitting hydrostatic pressure into the culture chamber C2 and if limitations in claim 1 drawn to the transmission of hydrostatic pressure do not represent an intended use, then Vetillard fails to anticipate claim 1 (Office Action page 5). The Examiner further asserts, however, that Jensen teaches the transmission of hydrostatic pressure in

the culturing of cells via microfermentation (relying on paragraphs 67-74, 190, and 194). The Examiner concludes that it would have been obvious to one having ordinary skill to modify Vetillard such that hydrostatic pressure is capable of promoting diffusion of desired compounds through the membranes M1, M2, and that only minor structural alterations would be necessary to generate hydrostatic pressure within the apparatus of Vetillard (Office Action page 6). The Applicants disagree.

The bioreactor in Vetillard is specifically configured and designed to promote the circulation of the dynamic fluid media F1 and F3 through the bioreactor in order to culture cells within the culture chamber C2 via hydrodynamic pressure. Accordingly, modifying Vetillard to cease the flow of the dynamic fluid media F1 and F3 in order to achieve hydrostatic pressure changes the principle of operation of the Vetillard bioreactor and, thus, such a modification would not be obvious to one having ordinary skill.

Vetillard teaches that the bioreactor is intended to be fed with three distinct dynamic liquid media F1-F3 via three characteristic inlet and outlet couples. As clearly shown in Fig. 1, each pair of inlet and outlet couple is longitudinally and angularly offset from one another relative to the central axis of the bioreactor. In particular, the three inlet and outlet couples EF1-EF3 and SF1-SF3, respectively, of the dynamic liquid media F1-F3 are positioned in three vertical planes passing through the axis of symmetry of the bioreactor. These planes are shifted by an angle of about  $60^{\circ}$  between the first inlet couple and the second inlet couple and by an angle of about  $120^{\circ}$  between the first inlet couple and the third inlet couple

(Paragraphs 100 and 103). The shifted location of these inlet and outlet couples delimiting the culture chamber make it possible to obtain an homogeneity of distribution of the liquid media within the chamber (Paragraph 97). In other words, each pair of inlet and outlet couple is specifically positioned to allow dynamic fluid media to proficiently cultivate the cells within the culture chamber C2.

If, however, the bioreactor was intended to operate under hydrostatic pressures such a configuration of the inlet and outlet couples would be unnecessary. In other words, the flow path of the fluid media F1 and F3 across either side of the culture chamber C2 affects the transfer of nutrients and waste through the membranes M1, M2 to such an extent that the inlet and outlet couples are strategically and purposefully positioned offset from one another. If the bioreactor were configured or intended to be operated under hydrostatic pressures, Vetillard would not have made concerted efforts to position the inlet and outlet couples in this specific manner. More specifically, if the bioreactor in Vetillard was intended to use hydrostatic pressure, the distribution of fluid media F1, F3 across either side of the culture chamber C2 would always be homogeneous because the media would be held static within the respective zone C1, C3 – as opposed to flowing through the zones along a fixed path as is the case in the current hydrodynamic operation of the bioreactor. Therefore, Vetillard would not purposefully position the inlet and outlet couples in the precise manner shown if a homogenous distribution of media could be established via hydrostatic pressurization. Accordingly, the precise inlet and outlet positioning is evidence that Vetillard did not contemplate the use of hydrostatic pressure.

Moreover, a regulation control unit in the bioreactor is used to receive information related to the dynamic fluid media F1-F3 and alters the various tanks, pumps, valves, and pressures existing in the zones C1-C3 of the culture chamber in order to modify on request the internal characteristics of the culture chamber and to change the parameters and the programs of regulation contributing to the homeostasy of the media in order to adjust to the cultivated cellular type (Paragraphs 110-111). Collectively, the devices of the bioreactor make it possible to maintain the homeostasy of the culture chamber by pre-conditioning the flows of the dynamic fluid media F1-F3 which penetrate into it in order not to enter the culture chamber an element of volume of culture media which could induce brutal disturbance of its physicochemical parameters (Paragraph 120).

In other words, as with the precisely oriented inlet and outlet couples, the regulation control unit of Vetillard is specifically constructed and configured to continually adjust and modify the characteristics and volume of *moving* fluids, e.g., the dynamic fluid media F1, F3 entering the zones C1, C3, in order to maintain homeostasy in the culture chamber. If the bioreactor was intended to hydrostatically apply pressure to the culture chamber, the entire regulation control unit would have to be redesigned.

Based on the foregoing, it is clear that the bioreactor of Vetillard is not intended to be operated under hydrostatic pressures, and one having ordinary skill would require far more than routine skill to modify Vetillard to operate in such a manner. Accordingly, one having ordinary skill would not modify Vetillard to operate under hydrostatic pressures as taught in Jensen. For these reasons, a *prima facie*

case of obviousness has not been shown and, thus, it is respectfully submitted that claim 1 is patentable over the combination of Vetillard and Jensen and is therefore allowable.

Claim 2 recites that the hydrostatic loading module transmits the pressure by a static second liquid medium. As noted, Vetillard does not teach or suggest using static fluids to cultivate cells within the culture chamber C2. Jensen does not cure the deficiencies of Vetillard because the teachings of Jensen do not negate the fact that is undesirable to modify Vetillard to operate under hydrostatic pressure. Accordingly, it is respectfully submitted that claim 2 is patentable over the combination of Vetillard and Jensen and is therefore allowable.

Claims 3-14 depend from claim 1 and are allowable for at least the same reasons as claim 1 and for the specific limitations recited therein.

Claim 42 recites that two membranes having substantially identical gas permeability are positioned on opposite sides of the first chamber. It is respectfully submitted that a *prima facie* case of obviousness has not been shown because modifying Vetillard to have identical membranes as taught in Jensen would destroy the intent and purpose of the Vetillard device.

Vetillard explicitly teaches that an object of the invention is to maintain a good cellular viability within the culture chamber and bioreactor by providing, on the one hand, to the cells of the culture media a nutrient supply in an adequate amount and, on the other hand by evacuating the waste and the inhibitor elements generated in order to allow a growth of the cell population. Another object of the invention is to be able to recycle the growth factors of the media while sufficiently evacuating cell

wastes from the culture media to thereby achieve economic optimization of the cells culture (Paragraphs 12-13). Accordingly, the membranes M1 and M3 in Vetillard are specifically configured to have different constructions, namely cutting thresholds of .2-.4 $\mu$ m and 10-12KDa, respectively (Paragraphs 41-42) in order to accomplish the dual objective of draining waste in one direction and replenishing the nutrient media tank in the other.

The Examiner asserts that one having ordinary skill in the art would have recognized that it would be beneficial to ensure that the Vetillard membranes were identical if both of the membranes interact with the same type of culture fluid or are intended to perform the same function (Office Action page 8).

Based, however, on the explicit teachings of Vetillard the dynamic liquid media F1 and F2 must be different in order for the bioreactor to properly function and the membranes M1 and M3 are never intended to perform the same function. As noted, Vetillard teaches that the bioreactor is designed to achieve economic optimization of the cells culture by recycling the growth factors of the media while sufficiently evacuating the cell wastes from the culture media. In other words, Vetillard states that multiple functions are performed on the cell culture by surrounding the cell culture with two different liquid media F1 and F2 and allowing the respective functions, *i.e.*, growth factor recycling and waste removal, to be performed through two membranes M1 and M3 having different cutting thresholds. In fact, Vetillard differentiates the membranes by designating each with the specified function each performs, namely the feeding membrane M1 and the dialysis membrane M3 (Paragraphs 41-42).

More specifically, the first liquid media F1 is specifically designed to feed the culture media in nutrient elements rich in growth factors (Paragraph 86). On the other hand, the second liquid media F2 is specifically designed to 1) introduce the cells to be cultivated into the chamber; 2) transport vectors of gene transfer and allow their setting in contact with the cells to establish a membrane fusion between the target cells and the vector of gene transfer; and 3) rinse the flow of inhibiting macromolecules present within the chamber (Paragraphs 88-89 and 92). Due to the different functions performed by the first and second liquid media F1 and F2, the membranes separating the liquid media from the cell culture must necessarily have different gas permeability, otherwise the operability and effectiveness of the bioreactor would be significantly frustrated.

If for example, the first and second membranes M1 and M3 both had a cutting threshold of .22  $\mu\text{m}$ , the growth hormones and large proteins provided by the first media F1 would be allowed to pass through the second membrane and into the waste disposal tank (see Figs. 4-6), thereby rendering the bioreactor incapable of replenishing the vessel R1 of fresh nutrient media during the ascending phase (Fig. 3). Therefore, the particularized functionality of the first and second liquid media F1 and F2 requires two different liquid media and therefore two membranes having different gas permeability. This is further evidenced by Vetillard repeatedly emphasizing the use of several *distinct* liquid media (*e.g.* Paragraphs 85 and 96) as well as the used of membranes having *different* cutting thresholds (*e.g.* Paragraphs 42 and 48). Accordingly, Vetillard does not teach, suggest or even contemplate using two substantially identical culture fluids or culture fluids that are

intended to perform the same function as the Examiner asserts. For these reasons, one having ordinary skill would not modify Vetillard to exhibit identical or similar culture fluids or membranes having substantially the same gas permeability as such a modification would clearly destroy the intent and purpose of the bioreactor of Vetillard.

The teachings of Jensen do not negate the undesirable effects of modifying Vetillard to utilize identical media F1 and F2 or to exhibit multiple membranes having substantially identical gas permeability. Accordingly, Jensen does not cure the deficiencies of the multi-function bioreactor taught by Vetillard. Based on the foregoing, modifying the bioreactor of Vetillard as proposed would destroy the intent and purpose of the bioreactor of Vetillard and, thus, the proposed modification of Vetillard would not be obvious to one having ordinary skill. For these reasons, a *prima facie* case of obviousness has not been shown and, thus, it is respectfully submitted that claim 42 is patentable over the combination of Vetillard and Jensen and is therefore allowable.

#### New Claims

Claim 43 recites that the inlet port and the outlet port are sealed during hydrostatic loading to allow the hydrostatic pressure of the first chamber to be increased without loss of first liquid medium from the first chamber. Vetillard does not teach or suggest this subject matter. As clearly shown in Fig. 6 of Vetillard, there is no indication that any of the modules C1, C2, C3 can be sealed during operation of the cell culture chamber in either the descending phase (Fig. 2) or the ascending phase (Fig. 3). Accordingly, Vetillard does teach or suggest the subject matter of



claim 43 and, thus, it is respectfully submitted that claim 43 is patentable over Vetillard and is therefore allowable.

Claim 44 recites that the second chamber is sealed to pressurize the second liquid medium and thereby transmit hydrostatic pressure through the gas permeable membrane and into the first chamber. As noted, there is no indication that any of the modules C1, C2, C3 in Vetillard can be sealed during operation of the cell culture chamber in either the descending phase (Fig. 2) or the ascending phase (Fig. 3). Accordingly, Vetillard does teach or suggest the subject matter of claim 44 and, thus, it is respectfully submitted that claim 44 is patentable over Vetillard and is therefore allowable.

In view of the foregoing, it is respectfully submitted that the present application is in a condition of allowance and allowance of the present application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this matter to our Deposit Account No. 20-0090.

Respectfully submitted,

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